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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,087	07/21/2009	Jason Teckoe	086887-0059	2544

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McDermott Will & Emery  
600 13th Street, NW  
Washington, DC 20005-3096

EXAMINER
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NGUYEN, THUKHANH T

ART UNIT	PAPER NUMBER
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1747

NOTIFICATION DATE	DELIVERY MODE
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10/18/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/573,087	<b>Applicant(s)</b> TECKOE ET AL.	
	<b>Examiner</b> THU KHANH NGUYEN	<b>Art Unit</b> 1747	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 5) ☒ Claim(s) 1-35 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1-35 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/29/2009 &amp; 2/05/2007</u> . | 6) <input checked="" type="checkbox"/> Other: <u>JP 10305395</u> .                      |

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## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 34 is objected to because of the following informalities: the phrase “sid gasket” seems to be a typo. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 16-35 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Simpson et al (5,074,102).

Simpson et al teaches an apparatus for encapsulating a powder in between two gelatin sheets, comprising a film preconditioner (21-31, 200), which includes a heater (21h) in the gelatin hopper, a linked track of cavity blocks (49) and heating members (col. 8, lines 7-18) are equivalent to the headed plate, wherein the cavity blocks comprise an array of plurality of vacuumed cavities (51), a filling head (69) for feeding a predetermined amount of powder material into the cavities (col. 8, lines 19-36), wherein the filling head (69) enters the mold cavities and compacts powder material to a uniform density, so that the final capsules contain equal dosages (col. 10, lines 48-56) and a vacuum shoe (200) in communication with each cavity through vacuum ports (58).

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In regard to claim 16, the cavity blocks (49, 50) and its heating members (col. 8, lines 7-18) are equivalent to the heated plate; wherein the film is capable on introducing to the cavities under vacuum.

In regard to claim 17, one of ordinary skilled in the art would provide additional vacuum ports anywhere on the cavity blocks, inside or outside of the mold cavity, in order to condition or directing the gelatin film (col. 7, lines 64-67). Further, the number of the vacuum apertures and the location of those apertures cannot be used to determined the patentability of apparatus claims. The court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). It has been held that by merely shifting the position of the parts without changing the operation of the mechanism will not render the claims patentable and the placement of the mechanism is an obvious matter of design choice. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975). Further, the position of parts is an obvious matter of design choice because shifting the position of parts would not have modified the operation of the device. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975).

In regard to claim 19, wherein each of the mold cavities (50) having a raised edge (52) and a sealing roll (85), which is equivalent to the cutting sleeve, for cutting the gelatin film (col. 6, lines 54-58).

In regard to claims 26, wherein the second film is applied above cavity filled with the first gelatin sheet and powder material under vacuum by the sealing roll (Fig. 10; col. 11, lines 36-48).

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In regard to claims 33-35, wherein the apparatus further comprises a gasket or a slotted control valve (300) for controlling the feeding of powder material into the mold cavities (col. 9, lines 4-27). In regard to the size of the gasket, it is inherent that one side of the gasket/valve has to be smaller than the other size for it to rotate and allow the material to be fed, while the larger half would block the material when feeding is undesired.

4. Claims 16-23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al (5,603,880) in view of Miyajima (6,080,354).

Regarding claim 16, Kato et al disclose an apparatus for forming tablets, comprising a film preconditioner, or a heater (16), a conveying platen (5) having a pocket, or die (10) for receiving said preconditioned film into the die (10) and receiving the powder (P); and a mechanical means (19, 20) for compacting the powder in the die (10).

However, Kato et al fails to disclose that the die include a vacuum to draw the film in the die prior to filling of the powder material.

Miyajima discloses a molding apparatus for molding powder material within two layer of films (30), wherein the film is brought into contact with the surface of the die by a suction mechanism (3:37-40).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Kato et al by providing a suction/vacuum mechanism as taught by Miyajima in order to pull the support film to the mold surface so that the film will completely line-up the die cavity so that the powder material can be filled to the correct amount and the tablet can be formed to the correct shape.

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Regarding claim 17, wherein Kato further discloses that the mold platen (5) comprises an array of dies (10).

Regarding claim 18, Miyajima further discloses a plurality of suction holes (33) around the circumference of the die (5). It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Kato by providing a plurality of suction holes around the circumference of the die as taught by Miyajima so that the film can evenly be drawn to the die surface.

Regarding claim 19, Kato further discloses that the array of dies (5) on the mold platen conveyor (10) which having a recessed surface between the raised edge profiles forming a circumference of a die (5), and a cutting sleeve (21) movable to interfere with the raised edge profile to cut the film surface (Fig. 3F).

Regarding claims 20-21, Kato et al further disclose that the molding dies can be arranged on a rotary table for forming tablets (1: 35-56) for forming a plurality of tablets in a short period of time.

Regarding claim 22, wherein the suction mechanism (32) in Miyajima is capable of cleaning the platen (5, 10).

Regarding claim 23, Kato et al further disclose a dosator and a dosing unit for dosing the pocket with powder, the dosator comprising a powder hopper (12) for holding the powder, and a dosing head having dosing tubes (3) for retaining powder from the powder hopper and transferring the powder to the pocket (Figs. 3C-D).

Regarding claim 25, wherein the feeding turntable (3) is movable between a charging position (12) to a dosing position (20).

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5. Claims 24 and 26-29 and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al (5,603,880) in view of Miyajima (6,080,354) as applied to claims 16-23 above, and further in view of Kato et al (6,227,836).

Regarding claim 24, Kato et al ('880) and Miyajima fail to disclose tamping pins for pre-compacting the powder. Kato et al ('836) discloses a powder compression apparatus, comprising filling pins (9, 109) for pressing the powder material from the feeding hopper into the mold cavity. It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Kato et al ('880) by providing the filling pins as taught by Kato et al ('836) in order to facilitate the filling of powder material into the mold cavities.

Regarding claim 26, wherein Kato et al ('880) fail to disclose a turntable for holding the die platen. Kato et al ('836) disclose a turntable (103) having a plurality of mold cavities (107) arranged in arrays along the circumference of the turntable (103). It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Kato et al ('880) by replacing the long conveyor belt with a turntable to support a plurality of die cavities as taught by Kato et al ('836) so that more mold cavities can be arranged in a smaller space which would save space to house the press machine and allow the press to produce at higher capacity.

Regarding claims 27-29, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Kato et al by providing a suction/vacuum mechanism as taught by Miyajima in order to pull the support film to the mold surface so that the film will completely line-up the die cavity so that the powder material can be filled to the correct amount and the tablet can be formed to the correct shape.

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Regarding claim 32, wherein the pressing station is separated from the rest of the plan, the compression force should inherently be isolated to the compression station.

Regarding claims 33-35, Kato et al ('880) further discloses that the conveyor (5) comprises an array of apertures for receiving more than one compacted powder slug from the compacting station (22) to transport and release the compacted powder slugs to a desired location.

6. Claim 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato et al (5,603,880) in view of Miyajima (6,080,354) and Kato et al (6,227,836) as applied to claims 24 and 26-29 and 32-35 above, and further in view of the JP reference (JP 10305395).

Kato et al fail to disclose that the turntable comprises different platens.

The JP reference discloses a rotary die table includes a plurality of individual, detachable/detachable die parts (4a, 4b) forming a turntable.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to modify Kato et al by providing the turntable made of different parts/platens as taught by the JP reference so that the die table and the punches can be detached and removed from the apparatus for cleaning, fixing, exchanging without the need to detach the whole apparatus.

### ***Double Patenting***

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).



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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-15 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-15 of prior U.S. Patent No. 7,625,622. This is a double patenting rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THU KHANH NGUYEN whose telephone number is (571)272-1136. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TN

/Richard Crispino/  
Supervisory Patent Examiner, Art Unit 1747